

REMARKS

Claims 9 through 13 and 18 through 33 are pending in this application.

Claims 9 and 26 have been amended to more clearly define the present invention.

Support for the amendment to claim 9 is found in the specification at page 2, lines 3-9. The claim 26 has been corrected to be commensurate with the specification. No new matter has been added.

No new matter has been added by this Amendment.

1. With respect to the examiner's points 1 and 2 (i.e., the abstract objection)

The abstract has been amended as suggested in MPEP §608.01(b).

Withdrawal of the objection is respectfully requested.

2. With respect to the examiner's point 3 (i.e., regarding IDS)

The examiner already withdrew his request in the Office communication dated on 8 September 2003 (Paper No. 0903).

3. With respect to the examiner's point 4

The examiner rejected claims 9-13 under 35 U.S.C. 112, first paragraph.

The rejection is traversed for the following reasons.

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue

experiments. *United States v. Telectronics, Inc.*, 867 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988).

First, the examiner's rejection is neither proper nor clear because claim 9 can be performed without undue experiments.

It is hardly understood why one reasonably skilled in the art could not make the invention from the disclosure without undue experiments. The examiner admitted that the process wherein the deposited tube is rotated while being heated by the circular heater is enabled. In view of this admittance and the feature of claim 9, it is understood that the examiner argued that claim 9 does not meet the enablement requirement because claim 9 does not include the feature of the rotation of the tube. However, this omission of the feature of the rotation of the tube does not make claim 9 improper. The court held that, "[a]s long as the specification discloses at least one method for making the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Also, failure to disclose other method by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Sepctra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir), *cert. denied*, 484 U.S. 954 (1987). In addition, in *In re Kamal and Rogier*, the court clearly held that "the mere possibility of inclusion of inoperative substances, if, indeed, operability is properly questionable under 35 U.S.C. 112, does not prevent allowance of broad claims. *In re Kamal and Rogier*, 158 USPQ 320, 324 (CCPA, 1968); *In re Sarett*, 51 CCPA 1180, 327 F.2d 1005, 140 USPQ 474 (CCPA, 1964).

Here, the specification discloses a preferred embodiment and the specification discloses at least one method for making and using the claimed invention (*i.e.*, a process wherein the deposited

tube is rotated while being heated by the circular heater) that bears a reasonable correlation to the entire scope of the claim. Even if the claim 9 includes the scope of a method without rotating the deposited tube and the examiner properly suspected the *possibility* of inoperative method, the enablement rejection is merely speculative and there is no factual basis for the enablement rejection (A mere possibility does not render the claim improper.) Moreover, MPEP 2164.08(b) states that “[t]he presence of inoperative embodiments within the scope of a claim does not necessarily render a claim non-enabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984).” Here, a skilled person could determine whether the embodiment wherein the deposited tube is not rotated while heating is inoperative or operative without undue experiment. It should be also noted that the test of enablement is not whether all the scopes of the claim is explicitly shown in the specification, but whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experiments.

Therefore, since (1) one reasonably skilled in the art could make the invention from the disclosures in the patent coupled with information known in the art without undue experiments; (2) the examiner’s enablement rejection is based only on the possibility of inoperability and there is no factual basis for the enablement rejection; and/or (3) a skilled person could determine which embodiments covered by claim 9 would be inoperative or operative with expenditure of no more effort than is normally required in the art, the examiner’s rejection is not proper.

Reconsideration of the rejection of claims 10-13 is also respectfully requested because the applicant has presented above reasons why independent claim 9 is patentable and claims 10-13 depend effectively from claim 9.

Second, with respect to the dependent claim 11, the examiner's rejection is not proper for the following additional reasons.

In the Office action, the examiner admitted that the process wherein the deposited tube is rotated while being heated by the circular heater is enabled. Specifically claim 11 claims the feature of the rotation of the deposited tube. Thus, claim 11 should not be rejected.

Therefore, withdrawal of the rejection is respectfully requested.

4. With respect to the examiner's point 5

The claims 9-13 and 18-25 stand rejected under 35 U.S.C. 112, first paragraph.

The examiner's rejection is traversed for the following reasons.

Claim 9 explicitly recites the step of "arranging the deposited tube in such a fashion that it extends vertically through a circular heater" and the step of "moving the circular heater to the sealed end of the deposited tube," and claim 18 explicitly states the step of "arranging the rod-joined deposited tube vertically and arranging a circular heater around the tube."

Since the specification discloses at least one method (e.g., the method admitted by the examiner in the Office action citing Fig. 2; page 10, the last paragraph; page 13, line 1) for making the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the

enablement requirement of 35 U.S.C. 112 is satisfied. Nonetheless, it looks like that the examiner improperly required the applicant to claim only the subject matters (*i.e.*, a process wherein the deposited tube is oriented within the circular heater such that the sealed end is the upper end) which are explicitly disclosed in the preferred embodiment. The examiner's enablement rejection is speculative and there is no factual basis for the inoperativeness. It should be noted that the mere possibility of inclusion of inoperative substances, if, indeed, operability is properly questionable under 35 U.S.C. 112, does not prevent allowance of broad claims. *In re Kamal and Rogier*, 158 USPQ 320, 324 (CCPA, 1968); *In re Sarett*, 51 CCPA 1180, 327 F.2d 1005, 140 USPQ 474 (CCPA, 1964). Furthermore, as stated above (MPEP 2164.08(b)), the presence of inoperative embodiments within the scope of a claim does not necessarily render a claim non-enabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more effort than is normally required in the art. Here, a skilled person could determine whether the embodiments having different orientations of the sealed end is inoperative or operative without undue experiment.

Therefore, since (1) one reasonably skilled in the art could make the invention from the disclosures in the patent coupled with information known in the art without undue experiments; (2) the examiner's enablement rejection is based only on the possibility of inoperability and there is no factual basis for the inoperativeness; and/or (3) a skilled person could determine which embodiments covered by claims 9-13 and 18-25 would be inoperative or operative with expenditure of no more effort than is normally required in the art, the examiner's rejection is not proper.

Accordingly, withdrawal of the rejection is respectfully requested.

5. With respect to the examiner's point 6

The claims 9, 10, 11 and 13 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Glessner *et al.* (U.S. Patent No. 4,636,236) in view of JP Publication No. 03-242342, Baumgart *et al.* (U.S. Patent No. 4,820,322) and O'Brien, Jr. (U.S. Patent No. 5,090,978).

Claim 9 as amended recites that the first heater and the circular heater use the different flame pressures. These features are not found in the references.

Also, the step of "arranging the deposited tube having the sealed end and an open end" in claim 9 is not disclosed in the cited references because Glessner '236 discloses only the step of arranging vertically the preform tube having only open ends (Fig. 2 of Glessner '236 shows the sealed end after arranging the preform tube having only open ends and heating the preform tube to seal one of the open ends. That is, the arrangement step is shown only in Fig. 1. (see column 4, lines 18-30)) and Baumgart '322 only discloses the step of arranging vertically the preform rod having only closed ends, not a preform tube having one open end.

Therefore, claim 9 is patentable, and its dependent claims 10, 11 and 13 are also patentable.


6. Incompleteness of the Office action

In the Office action, the examiner did not examine or reject claims 26 to 33 even if the claims 26 to 33 were added in the preliminary Amendments filed on January 31, 2002 with the divisional application. The allowance of claims 26 to 33 is respectfully requested.

No fee is incurred by this amendment. Should the other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Reconsideration of the rejections and objections is requested. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,



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